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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,332	08/20/2001	Gregory P. Fitzpatrick	BOC9-2001-0007 (242)	5985
40987	7590	09/08/2005	EXAMINER	
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			BILGRAMI, ASGHAR H	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,332

Applicant(s)

FITZPATRICK ET AL.

Examiner

Asghar Bilgrami

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 36-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 36-64 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-30 & 36-62 are rejected under 35 U.S.C. 102(e) as being anticipated by Gudjonsson et al (U.S. 6,564,261 B1).

3. As per claims 1, 18 & 36 Gudjonsson disclosed a method for sharing contact list information between participants of a chat session, comprising: identifying a first contact list containing contact information relating to contacts of said first chat session participant and identifying a second chat participant having a second contact list containing contact information relating to contacts of the second chat participant, said first chat session participant and said second session participant participating within a common chat session; providing the second chat participant with access to contact information contained within the first contact list and providing the first session participant with access to information contained within said second contact list (col.24, lines 32-43, col.25, lines 6-20, col.27, lines 36-44, col.29, lines 64-67 & col.30, lines 1-30).

4. As per claims 2, 17, 20, 37, 52, 55 & 60 Gudjonsson disclosed the method according to claim 1, further comprising the steps of: determining whether said first contact list is modifiable

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by said second chat, session participant; and if said first contact list is modifiable by said second chat session participant, permitting the modification of said first contact list by said second chat session a participant (col.25, lines 6-20 col.26, lines 59-67 & col.27, lines 1-4).

5. As per claims 3 & 38 Gudjonsson disclosed the method according to claim 2, wherein said modification step comprises the step of adding contact information to said first contact list 9col.27, lines 36-44).

6. As per claims 4, 5, 6, 7, 21, 22, 39, 40, 41, 42, 56, 57, 63 & 64 Gudjonsson disclosed the GUI according to claim 40, further comprising the step of displaying an icon within a chat session interface used by the first chat session participant to indicate whether said second contact list is accessible to said first session participant (col.25, lines 6-20 col.26, lines 59-67 & col.27, lines 1-4 col.30, lines 1-16 & col.26, lines 40-58).

7. As per claims 8 & 43 Gudjonsson disclosed the method according to claim 1, further comprising the steps of: identifying a third chat session participant maintaining a third contact list containing contact information relating to contacts of said third chat session participant, said third chat session participant participating within said common chat session; and providing the third session participant with access to the contact information contained within the first contact list and the second contact list and providing the first chat session participant and said second session participant with access to contact information contained within the third contact list (col.4, lines 31-33, col.29, lines 64-67, col.30, lines 1-16 & col.26, lines 40-58).

8. As per claims 9 & 44 Gudjonsson disclosed the method according to claim 8, further comprising the steps of: : permitting the selection of said displayed icon for said first contact list and said displayed icon for said second contact list by a third chat session participant having a third contact list; comparing said selected first contact list and said selected second contact list to said third contact list (col.30, lines 1-16 & col.26, lines 40-58); and displaying to said third chat session participant contacts that are common to said first selected contact list, said second selected contact list, and said third contact list according to results from said comparing step (col.30, lines 15-29).

9. As per claims 10, 24, 26, 27, 45, 59 & 61, 62 Gudjonsson disclosed the method according to claim 9, further comprising the steps of: permitting any of said first chat session participant, said second chat session participant and said third chat session participant to modify any of said first contact list, said second contact list and said third contact list (col.27, lines 36-44) according to results from said comparing step col.26, lines 37-58); and permitting any of said chat session participants associated with said contact list to reject said modification (col.25, lines 6-20).

10. As per claims 11, 12, 47 & 46 Gudjonsson disclosed the method according to claim 7, wherein if said display icon indicates that said first contact list is not modifiable, further comprising the step of requesting said first chat session participant to allow said second chat session participant to modify said contact list (col.25, lines 21-42).

11. As per claims 13-16, 19, 23, 25, 29, 28, 30, 48-51, 53, 54 & 58 Gudjonsson disclosed a method for providing contact management to parties engaged in a chat communication session, the method comprising: identifying a first contact list containing contact information relating to contacts of said first chat session participant and identifying a second chat participant having a second contact list containing contact information relating to contacts of the second chat participant, said first chat session participant and said second session participant participating within a common chat session; providing access for said first contact list to a second participant to the communication session (col.26, lines 30-50); identifying similar contacts between contact records located in said first contact list and contact records located in said second contact list; and adding selected dissimilar contact records located in said first contact list to said second contact list (col.29, lines 64-67 & col.30, lines 1-30).

Response to Arguments

12. Applicant's arguments filed 05/02/2005 have been fully considered but they are not persuasive.

13. When reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

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14. The applicant argued, "Gudjonsson fails to teach that one chat session participant can let another chat session participant access his her contact list".

15. As to applicants argument Gudjonsson specifically talks about "Sharing" contacts between two users participating in a chat session (col.29, lines 64-67 & col.30, lines 1-30)

Conclusion

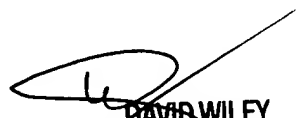
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asghar Bilgrami whose telephone number is 571-272-3907. The examiner can normally be reached on M-F, 8:00-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


AB

Asghar Bilgrami
Examiner
Art Unit 2143


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